



UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE
United States Patent and Trademark Office
Address: COMMISSIONER FOR PATENTS
P.O. Box 1450
Alexandria, Virginia 22313-1450
www.uspto.gov

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/036,185	12/28/2001	Michele Borgatti	32079-82	4873

7590 03/14/2005

JENKENS & GILCHRIST, P.C.
3200 Fountain Place
1445 Ross Avenue
Dallas, TX 75202-2799

EXAMINER

MYERS, PAUL R

ART UNIT	PAPER NUMBER
----------	--------------

2112

DATE MAILED: 03/14/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary	Application No.	Applicant(s)	
	10/036,185	BORGATTI ET AL.	
	Examiner	Art Unit	
	Paul R. Myers	2112	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 12 January 2005.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-11 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-11 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

Response to Arguments

1. Applicant's arguments with respect to claims 1-11 have been considered but are moot in view of the new ground(s) of rejection.

In regards to applicants argument that Kamepalli does not teach the expansion module comprising the "reconfigurable unit adapted to be in circuit modified to establish connections within the module, implement a certain class of functions, and control the module components to support the implemented class of functions": The previous examiner appeared to point to the wrong item. In that the item that does the reconfiguring and not the item that is reconfigured was pointed to. Each of the controllers F0-F7 are reconfigurable units.

In regards to applicants argument that Kamepalli does not teach the expansion unit comprising "a software algorithm adapted to instruct the control device in the circuit modification of the reconfigurable unit": It appears the previous examiner missed that the comprising language for the expansion unit, and treated it in the comprising language of the electronic system. Thus while the current examiner agrees that the electronic system that includes the expansion unit does is reconfigured by a BIOS software algorithm, the Bois algorithm does not appear to be stored within the expansion unit itself.

Claim Rejections - 35 USC § 103

2. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person

Art Unit: 2112

having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

3. Claims 1-11 are rejected under 35 U.S.C. 103(a) as being unpatentable over Kamepalli PN 6,647,434 in view of Chen et al PN 5,933,652.

In regards to claims 1 and 7-11: Kamepalli teaches an electronic system, comprising: a portable host device (Fig 1; column 1 lines 18-21) having a connector (118); and an expansion module (multifunction device) adapted for quick-connect engagement in and disengagement from the portable device via the connector (118), comprising: one or more peripheral devices adapted to serve different classes of functions (Fig 2, multifunction device 121; Column 3 lines 41-54); a non-volatile memory for storing information that pertains to circuit configuring the different classes of functions in the module (Fig 3, Col 3 lines 45-54, Col 5 lines 22-34); a reconfigurable unit adapted to be circuit modified to establish connections within the module, implement a certain class of functions, and control the module components to support the implemented class of functions (any of the controllers F0-F7 or all taken together); and a control device (207) adapted, in cooperation with the host device, to control the circuit modification of the reconfigurable unit to support the implemented class of functions. While Kamepalli does teach a software algorithm adapted to instruct in circuit modification of the reconfigurable unit, Kamepalli does not teach the BIOS software algorithm being stored within the expansion unit. Chen et al teaches a peripheral adapter coupled to a Host that includes its own extension BIOS. It would have been obvious to store the control software for the expansion module within the expansion module because this would have prevented the use of the wrong control software.

In regards to claim 2: Kamepalli discloses a method of reconfiguring the functionality of a portable electronic device, comprising; connecting an expansion module to the portable

Art Unit: 2112

electronic device (e.g. col. 3, lines 11 et seq.); reading applications resident on the portable electronic device (col. 5, lines 5 et seq.); upon receiving a request to activate a new function to be provided by the portable electronic device (e.g. col. 6, lines 10-41), automatically reconfiguring the expansion module to provide the new function requested (e.g. col. 6, lines 10-41).

In regards to claim 3: "wherein the step of automatically reconfiguring comprises verifying that the request is consistent with the functions that are capable of being provided by the expansion module" is within the teachings of Kamepalli (see col. 3, line 65 - col. 4, line 19).

In regards to claims 4 and 6: "wherein the step of automatically reconfiguring comprises selecting components within the expansion module to perform the new function requested, and deselecting components within the expansion module that are not needed to perform the function requested" is within the teachings of Kamepalli (see col. 4, lines 20-46).

In regards to claim 5: Kamepalli teaches signaling completion of the reconfiguring (e.g. col. 5, line 65-col. 6, line 11).

Conclusion

4. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

WO 99/33243 to Leong teaches a reconfigurable expansion module as claimed above excepting that the Host is not necessarily portable and the control program is downloaded to the Expansion module.

PN 5,615,344 to Yanai et al teaches a reconfigurable adapter.

PN 4,868,783 to Anderson teaches a reconfigurable device adapter.

Art Unit: 2112

PN 5,247,633 to Nissimov teaches an adapter with its own extension BIOS.


WO 94/11802 to Corder teaches a reconfigurable adapter with its own stored operations program.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Paul R. Myers whose telephone number is 571 272 3639. The examiner can normally be reached on Mon-Thur 6:30-4:00.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Mark Rinehart can be reached on 571 272 3632. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

PRM
March 9, 2005


PAUL R. MYERS
PRIMARY EXAMINER